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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,371	09/04/2001	Hiroko Sukeda	H-991	1281
24956	7590	06/29/2006	EXAMINER	
MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.			VAN BRAMER, JOHN W	
1800 DIAGONAL ROAD			ART UNIT	
SUITE 370			PAPER NUMBER	
ALEXANDRIA, VA 22314			3622	

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/944,371		SUKEDA ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	John Van Bramer		3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-7 and 9-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7 and 9-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed on April 4, 2006, cancelled Claim 4 and Claim 8. No new claims were added, and Claims 1, 2, 5, 6, 12, and 13 were amended. Thus the currently pending claims are Claims 1-3, 5-7, and 9-13.

### ***Claim Objection***

2. The amendment filed on April 4, 2006 corrected the deficiencies in Claim 6, detailed in the Office Action dated November 4, 2005. Therefore, the examiner hereby withdraws the objection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5-7, and 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarbin et al (U.S. Patent Number: 5,179,517).

Claims 1 and 2: Sarbin discloses a smart card system, and a smart card, comprising:

Art Unit: 3622

- A. A smart card(Fig 2, and Col 4, lines 13-18); and at least one terminal which is accessible to said smart card (Col 4, lines 59-62), said smart card comprising:
- a. An I/O interface for exchanging data via said terminal. (Col 3, lines 50-64)
  - b. An operating system. (Col 3, line 50 – Col 4, line 3 and Col 6, lines 16-36)
  - c. An application program unit including:
    - i. A data storage unit, which stores, first point data and second point data. (Fig. 5; Col 6, line 48 – Col 7, line 7; and Col 8, lines 6 – 14) (The first point data is collected in field 98 of Figure 5, the second point data is collected in field 102 of Figure 5)
    - ii. A program execution unit which accesses said data storage unit and executes a game defined by said game defining data. (Col 6, lines 16-36)
    - iii. Wherein the first point data is added from outside the smartcard through said I/O interface according to a customer's utilization history. (Col. 5, line 60 through Col 6, line 4)
    - iv. Wherein goods and services are exchangeable for accumulated points among the first point data and the second point data. (Col 5, lines 39 – 54; and Col 7, lines 28 – 54) (Sarbin teaches that the second point data consists of prizes, premiums and awards and that first point data consists of objects containing monetary value such debit and credit cards.

Therefore, both first and second point data are exchangeable for goods and services.)

- v. Wherein the program execution unit subtracts points from the first point data in exchange for a game execution and adds points gained as a result of game execution to the second point data. (Col 7, lines 8-27; and Col 7, line 55 – Col 8 line 5) (The accumulation of the prizes, premiums and awards are a result of game play. Execution of the game is subtracted from the first point data.)

While Sarbin is silent with regard to prohibiting game execution in exchange for subtracting points from the second point data, the exchanging of prizes, premiums and awards for game execution is also never proposed in the Sarbin teachings. However, since an embodiment of Sarbin whereby the exchanging of bonus data for prizes, premiums and awards is disclosed as being performed by employees. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that at least one embodiment of the disclosed system would prevent using such second point data for game play execution. One would have been motivated to utilize this embodiment in order to provide customers with personalized recognition of their accomplishments from employees of the company and thereby increase the customer's likelihood for continuing to visit and use the games provided by the company.

Claim 3: Sarbin discloses the smart card according to claim 2, wherein, when the value of points stored in the smart card is subject to an inquiry, the sum of the first point data and the second point data is returned. (Col 8, lines 6-13)

Claim 5: Sarbin discloses the smart card according to claim 2, wherein, when points are to be subtracted from the smart card in exchange for a service corresponding to the value of the points, a point value is firstly subtracted from the second point data, and also subtracted from the first point data if the point value in the second point data is less than the points to be subtracted (Col 7, lines 28 – lines 54). While Sarbin does not explicitly disclose the order of point subtraction relative to the two separate database fields, including such functionality would have been obvious to one having ordinary skill in the art at the time the invention was made to allow for the processing of discounts or upgrades that have been awarded as a result of game play. One would have been motivated to provide this functionality in order to provide customers with loyalty awards that are more cost effective to provide than direct cash awards. As indicated the order of point subtraction claimed would occur in the event the service provided is a discount or upgrade (i.e. 25% off on the price of a meal or an upgrade from business class to first class on an airline). The redemption of the discount or upgrade would result in the Bonus Data field (102) in Fig 5. being decremented first in order to obtain the discount and the data in the Debit/Credit field (98) being subsequently decremented for the remaining price of the service. Admittedly the customer could pay for the remaining balance for the service

provided with cash or credit that would not reduce the Debit/Credit field. However, the option to utilize the Debit/Credit field exists and its use would result deductions as stated in the claim.

Claim 6: Sarbin discloses the smart card according to claim 2, wherein, when points are to be subtracted from the smart card in exchange for a reason other than game execution, a point value is firstly subtracted from the first point data, and also subtracted from the second point data if the point value in the first point data is less than the point to be subtracted. While Sarbin does not explicitly disclose the order of point subtraction relative to the two separate database fields, including such functionality would have been obvious to one having ordinary skill in the art at the time the invention was made to allow for the return of the smart card and the redeeming of points earned for cash. One would have been motivated to provide this functionality in order to provide customers with an incentive to utilize the smart card in lieu of cash. When a customer returns their card to cash out, the order of point subtraction claimed would occur. The Debit/Credit field would be decremented in order to refund the card balance and the customer would then have the option of redeeming points in the Bonus Data field for other awards, including cash awards. Admittedly the customer could redeem the points in the Bonus Data field without redeeming the points in the Debit/Credit field, or redeem the points in the Bonus Data field prior to redeeming the points in the Debit/Credit field, however, the option to affect the return of points could be accomplished in the order claimed.

Claim 7: Sarbin discloses the smart card according to claim 2, wherein, when a game is to be executed on the smart card, a point value determined corresponding to the game to be executed is subtracted from the first point data, and if the point value is greater than the first point data, the game cannot be executed. (Col 5, lines 60-68 and Col 7, line 55 – Col 8, line 5). Due to the differentiation stated between the debit and credit methods, utilization of the debit method would prevent execution when the Debit/Credit field (98) did not contain a positive balance.

Claim 9: Sarbin discloses the smart card according to claim 2, wherein log data on processing of an application on the smart card is stored in the smart card and the log data can be referred to from the outside. (Col 9, lines 36 – 45)

Claim 10: Sarbin discloses the smart card system according to claim 1 wherein said terminal has a game execution function which enables execution of the game held in said smart card (Col 4, lines 47 – 58).

Claim 11: Sarbin discloses the smart card system according to claim 10, wherein said game execution function can be selected whether to be provided or not (Col 4, lines 47-58).



Claim 12: Sarbin discloses a method for providing a loyalty program using a smart card, comprising the steps of:

- A. Managing point data by an application program on the smart card. (Col 6, line 48 – Col 7, line 7)
- B. Issuing a point in response to a product purchase and adding the issued point from outside the smart card through an I/O interface to first point data in the smart card according to utilization history. (Col 5, lines 60-69)
- C. Generating a point in response to a result of playing a game loaded in the smart card and adding the generated point to second point data in the smart card. (Col 7, lines 8-27)
- D. Controlling to provide a game service according to a value of points in said first point data. (Col 5, lines 60-68 and Col 7, line 55 – Col 8, line 5).
- E. Wherein goods and services are exchangeable for accumulated points of the first point data and the second point data. (Col 5, lines 39 – 54; and Col 7, lines 28 – 54) (Sarbin teaches that the second point data consists of prizes, premiums and awards and that first point data consists of objects containing monetary value such debit and credit cards. Therefore, both first and second point data are exchangeable for goods and services.)

F. Wherein a game execution in exchange for subtracting points from the second point data is prohibited.

While Sarbin is silent with regard to prohibiting game execution in exchange for subtracting points from the second point data, the exchanging of prizes, premiums and awards for game execution is also never proposed in the Sarbin teachings. However, since an embodiment of Sarbin whereby the exchanging of bonus data for prizes, premiums and awards is disclosed as being performed by employees. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that at least one embodiment of the disclosed system would prevent using such second point data for game play execution. One would have been motivated to utilize this embodiment in order to provide customers with personalized recognition of their accomplishments from employees of the company and thereby increase the customer's likelihood for continuing to visit and use the games provided by the company.

Claim 13: Sarbin discloses the method for providing a loyalty program according to claim 12, wherein the step of controlling to provide a game service includes the step of subtracting from said first point data a predetermined point value corresponding to the game to be executed. (Col 5, lines 60-68 and Col 7, line 55 – Col 8, line 5). Due to the differentiation stated between the debit and credit

methods, utilization of the debit method would prevent execution when the Debit/Credit field (98) did not contain a positive balance.

### ***Response to Arguments***

5. Applicant's arguments filed April 4, 2006 have been fully considered but they are not persuasive.

a. The applicant argues that Sarbin does not disclose that first point data added through an I/O interface according to a customer's utilization history may be subtracted in exchange for a game execution. However, Sarbin discloses that a customer may be issued a new card, or present a previously issued card for an employee to update the debit or credit field (Col 7, lines 55 – 68). The card is then used for game execution.

b. The applicant argues that Sarbin allows points added as a result of game execution to second point data to be used in exchange for game execution. However, Sarbin only discloses that the second point data can be exchanged for prizes, premiums, or awards. Sarbin never indicates that these bonuses could be used in exchange for game execution.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 9am - 5pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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